

End New ClaimsRemarks

I.

Applicant has deleted Figure 9 and added new Figure 9 therefore and has added new Figures 10 and 11. Figure 9 graphically describes the claimed method by describing the series flow of the steps in the inventive method. New Figures 10 and 11, and the New Paragraphs added by this amendment, show every feature of the claimed invention as necessary for an understanding of the claimed invention by one skilled in the art of bowling. Figures 10 and 11 show, in connection with what is known from the prior art and by one skilled in the art, as for example as shown in U.S. Patent 4,371,163, the forces on the bowler's finger pad using finger tip control to lift the ball at its release to rotate the underside of the ball and apply spin to the ball. With the thumb removed from the ball, as demonstrated in Patent 4,371,163, the fingers are used to rotate the ball, requiring force applied from the fingers (and not the thumb) to the ball finger hole and producing a counter force from the ball against the fingers, as would be known from those skilled in the art and as described in the Declaration of Randall A. Addington, who by his Declaration, now of record of this application, has shown he is one skilled in the art of bowling and which is not disputed by Examiner in the Final Rejection.

The public, comprising those skilled in the art, within the scope of 35 USC 112 and 113, Rule 1.83(a) and 1.83(c), and MPEP §601.01(f), would understand the way a bowler uses finger tip control to lift the ball at its release from the middle or index finger and with the thumb removed, and the basic principle of a force required to be applied from the finger to rotate the ball and that in applying the force, to lift the ball in its release when the arm in a up swing, there would be a counter force applied from the bowling ball against the finger pad in contact with the bowling ball hole through the inventive finger pad shield and the contact area made with the finger pad.

That no new matter has been added is demonstrated by Examiner's dropping all issues under 35 USC 112, by objecting to, rather than rejecting the claims for the reason given in relation to the drawings, and because, as Examiner has stated in Paper No. (No paper number given, Confirmation Number 7581, mailed 6/24/2002), in pages 3 and 4, and particularly for example, on page 4, line 11), wherein Examiner states, "... lift as it pertains to delivery of a bowling ball is old and well known in the art," and in lines 15 -16, "one skilled in the art of bowling and viewing Marinese, would be familiar with the delivery of a bowling ball and the inherent forces involved. (Applicant, while agreeing that lift as it pertains to bowling is well known, disputes that Marinese teaches or discloses any facts related to lift, or the delivery of a bowling ball with lift, or the inherent forces involved.)

Accordingly, the application as filed, including its drawings and claims, together with what one skilled in the art of bowling would understand from the application, discloses the claimed invention and its best mode as necessary for its understanding of the invention as claimed and applicant's addition to the specifications and drawings add no new matter and particularly no new matter describing, "lift," "forces of lift," "relationships between the finger, finger shield and the ball, pressure, direction of forces, etc," to the extent identified by Examiner in the Final Rejection, (No paper number given, Confirmation Number 7581, mailed 6/24/2002), and Examiner's Objection made under R. 1.83(a) and 1.81(c) should be vacated.

II.

New Claims 31 to 33 have been added as follows.

New Claim 31 is claim 14 reduced by removal of the explicit recitation of steps Examiner has said is known to those skilled in the art. New Claim 31 reduces the complexity of the Claims and any issues which may arise therewith on appeal, while Claim 31, incorporating therein what is known and understood to one skilled in the art of bowling, remains constrained to the scope of Claim 14, and new Claim 31 requires no new examination.

Claims 32 and 33 are dependent from Claim 31 and within the scope of Claim 31. It recites within the scope of Claim 31, steps recited in Claim 15 and requires no new examination.

Accordingly, new Claims 31, 32 and 33, should be admitted into this case as within the scope of the existing claims, as reducing the complexity of the claims and any possible issues which may arise on appeal as to elements which may be identified as within the prior art and removed from argument.

III.

Claims 3 and 4, and Claims 14-30 and new Claims 31-33, are not anticipated by Marinese, as stated by Examiner.

A.

Substantial Evidence Standard for Patent Examination

The examination standard for patents is the standard of substantial evidence, requiring Examiner's findings be supported by substantial evidence in the record. The substantial evidence standard of review for a Patent Office rejection requires a complete record of all of the facts and reasoning that were used or should have been used, in support of the Examiner's conclusions.

Rule 116 Amend., 09/396,530, filed 9/15/99, page 5

The substantial evidence standard (hereafter "Examination Standard of Substantial Evidence, or Substantial Evidence Standard"), requires a finding of such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.

In re. Zurko 258 F.3d 1379 (Fed. Cir) 2001, at 1384.

Basic knowledge or common sense, which is not based on any evidence in the record, lacks substantial evidence support.

id. at 1385.

Patent Office expertise is restricted to the support of conclusions "as to peripheral issues," However,

With respect to core factual findings in a determination of patentability ... the [Examiner] cannot simply reach conclusions based on its own understanding or experience -or on [Examiner's] assessment of what would be basic knowledge or common sense. Rather, the [Examiner] must point to some concrete evidence in the record in support of.. [Examiner's] findings.

Id at 1385, 1386.

Required in support of a rejection is concrete evidence in the record. *In re. Zurko* 258 F.3d 1379 (Fed. Cir) 2001, at 1386.

Examiner's grounds for rejection must be reversed when factual findings underlying Examiner's stated grounds of rejection are not supported by concrete evidence in the record. *In re. Zurko* 258 F.3d 1379 (Fed. Cir) 2001, at 1386

B.

Examiner's grounds for rejecting Claims 14-30 and 3 and 4, are do not meet the Examination Standard Substantial Evidence and cannot support rejection of the aforesaid claims.

1. Claim 14 is not anticipated by Marinese

a) Examiner's statements of what Marinese discloses is not supported by the Examination Standard of Substantial Evidence of record based facts and is incorrect.

Examiner is incorrect that Marinese shows, as stated by Examiner,

The apparatus of Marinese transmits the forces applied by the bowler's fingers to the finger pad and then to the bowling ball to control the release and lift placed on the ball as called for in [Claim 14], steps d-e.

(underlining added)

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 9 to 11)

Examiner has not shown any substantial evidence, meaning record based facts supporting his statement, above, according to the Examination Standard of Substantial Evidence (See III. A, above). While the apparatus of Marinese does transmit forces from the bowler's thumb to the bowling pad, there are no record based facts in Marinese as shown or disclosed by Examiner as disclosing a force transmitted from the finger pad or a force applied from the bowler's fingers to control the release and lift placed on the ball.

To accept Examiner's argument, requires acceptance of Examiner's conclusions based on Examiner's knowledge and without substantial evidence, as required by the Examination Standard of Substantial Evidence, of where in Marinese are disclosed the recitations in Claim 14 (which are inaccurately paraphrased by Examiner (See Paper No. [no Paper No., [Confirmation Number 7581] mailed 6/24/2002, page 3, lines 9 to 11), as shown immediately above in this Section III., B., i., and accurately reproduced in part below, from the record. From the record, Claim 14 paragraphs d. e, and f, is as follows.

d. releasing said finger pad of a bowler and said finger pad shield from said finger hole of a bowling ball by applying a first force from said finger pad of a bowler in a first direction against said first surface of said finger pad shield, through said finger pad shield to said second surface of said finger pad shield, against said interior surface of said finger hole of a bowling ball, to lift said bowling ball and producing a second force in a second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield;

e. said step d. of releasing said finger pad of a bowler and said finger pad shield from said finger hole of a bowling ball, includes the step of receiving said second force in said second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, through said finger pad shield to said first surface of said finger pad shield and over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield; and

f. said step e. of receiving said second force in said second direction from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, includes the step of distributing said second force, in said

second direction from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield, for reducing a pressure over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield, produced by said second force, in a second direction from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield.

(underlining added)

There is no substantial evidence shown by Examiner, as record based facts in *Marinsec*, and as required by the Standard of Substantial Evidence, disclosing the underlined recitations of Claim 14, above, as abstracted from the above full recitations and reproduced here in the following as,

From step d: releasing said finger pad of a bowler and said finger pad shield from said finger hole of a bowling ball, by applying a first force from said finger pad, to lift said bowling ball,

From step e: said step d, of releasing, includes the step of receiving said second force, over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield, and

From step f: said step e, of receiving said second force, includes the step of distributing said second force, over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield, for reducing a pressure over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield.

To meet and satisfy the Examination Standard of Substantial Evidence and accord Applicants due process, Examiner's evidence of anticipation must include specific references to the disclosure of *Marinsec*, disclosing or teaching the underlined recitations of Claim 14. Examiner's statement of rejection of Claim 14 under 35 USC 102(b), provided below as,

The apparatus of *Marinsec* transmits the forces applied by the bowler's fingers to the finger pad and then to the bowling ball to control the release and lift placed on the ball as called for in [Claim 14], steps d-e.

(underlining added)

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002),

page 3, lines 9 to 11)

is limited to Examiner's conclusions without any record based facts to support those conclusions and fails to meet the Standard of Substantial Evidence. Instead, Examiner insists he be taken at his word, that his unsupported conclusions are correct. If, as Examiner insists, Marinese discloses controlling the release and lift placed on the ball as called for in steps d-e (See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 9 to 11), then Examiner must show the facts in the record of Marinese, supporting Examiner's conclusions. Examiner's Office Actions fail to provide those supportive facts.

vi. Examiner has used his own judgment instead of the record facts, to support Examiner's statements of what Marinese discloses and why Marinese anticipates Claim 14. The Examination Standard of Substantial Evidence requires, with respect to core factual findings in a determination of patentability, that Examiner cannot simply reach conclusions based on its own understanding or experience, or on Examiner's assessment of what would be basic knowledge or common sense. Rather, the Examiner must point to some concrete evidence in the record in support of.. Examiner's findings. (See III., A., above)

b. Examiner misstates and misapplies the Doctrine of Inherency.

Examiner's statement relying on the Doctrine of Inherency is incomplete and as an incomplete statement, it is a misleading and incorrect statement of the law.

The clear directions of MPEP 2112, with regard to the Doctrine of Inherency, is,

- a) Examiner must provide rationale or evidence tending to show inherency,
- b) To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill
- c) In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior anticipation.

See MPEP §2112 Requirements of Rejection Based on Inherency: Burden of Proof

Examiner has limited the grounds of his rejection of Claim 14 to recited elements he identifies in Marinese (See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002) page 3, lines 7-10, and to the

statement that Marines transmits forces from the bowler's fingers to the ball to control release and lift placed on the ball "as called for in steps d-e," (See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), Page 3, lines 9-11.

Examiner admits Marinese is not a complete anticipation of Claim 14, and his rejection under 102(b) is incomplete, stating,

While these "applying a a first force," producing a second force" and how these forces interact with the finger pad and the bowling ball are not specifically disclosed [in Marinese], it is noted, that in method claims, the prior art anticipates a claimed invention if the device carries out the method during normal operation.

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002, page 3, 11-14.

Examiner then attempts to cure the 102(b) rejection deficiency, finding by inherence or in the inherent operation of Marinese, the elements in paragraphs d-e in Claim 14, not explicitly taught in Marinese, based on an incomplete, and incorrect, and misleading statement of the "principles of inherency," (See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 14-16.

Examiner finishes his 102(b) rejection based on the inherent operation of Marinese, with the conclusions,

... the apparatus of Marines and the instant invention are being used to transmit forces from a bowler's hand to a bowling ball which is old and well known.

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 16-19), and

Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claim, then the method claim will be considered to be anticipated by the prior art.

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 14-16).

However, Examiner neglects to provide rationale or evidence tending to show inherence, or to establish inherency, as required by MPEP §2112, particularly by the requisite extrinsic evidence which makes clear that the missing descriptive matter is necessarily present in Marinese and that it would be so recognized by persons of ordinary skill or in relying upon the theory of inherency, or provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of Marinese. Examiner's two statements, immediately above, do not explain by record facts, as required by MPEP

§2112, how the inherent method of Marinese performs or anticipates any of the elements d-e of Claim 14.

c. Examiner's incomplete 102(b) rejection cannot be cured by application of the Doctrine of Inherency.

i. Marinese is limited to a disclosure of exclusively using a thumb protector and thumb actuated gripping device (which Applicant asserts is an inoperative method for releasing the ball and applying lift to the ball, as shown in U.S. Patent 4,371,163 of Shaffer (hereafter "Shaffer") col. 3, lines 47-60, and as would be known to, or used by, those skilled in the art, see Randall A. Addington Declaration, Section 5), for control of the ball and for its free release, while protecting the thumb. (See Marinese, col. 1, lines 63 to 69, col. 3, lines 22-43). While Marinese does refer to the pressure exercised by the thumb in controlling the ball, (See Marinese, col. 1, lines 10-19), and the thumb rather than the fingers, in the control of the ball (See Marinese, col. 3, lines 40-43), Marinese cannot anticipate the recited elements of Claim 14, as stated in III., B., I., above, by inherency or by reading into Marinese what one skilled in the art of bowling would know because the inherent operation or method of Marinese is inoperative for applying lift, as known to those skilled in the art (see reference to Shaffer and the Randall A. Addington Declaration), Marinese does not disclose or teach anything about lift and the Marinese method is incompatible with the method of Claim 14, particularly as recited in paragraph d, reciting "lift," (see reference above to the Randall A. Addington Declaration, Section 5)

"Lift," is a term to describe the spin placed on the ball, as known and understood by those skilled in the art (See Shaffer, col. 3, lines 47-60 and the Randall A. Addington Declaration), using the middle finger or middle two fingers to impart direction and spin to the ball.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in Marinese, and that it would be so recognized by persons of ordinary skill and in relying upon the theory of inherency, Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior anticipation. MPEP§2112.

Examiner has failed to show by record based facts, any extrinsic evidence that the missing descriptive matter necessary for Examiner to state the facts meeting a 102(b) rejection, is necessarily present in Marinese, and that it would be so recognized by persons of ordinary skill or a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic. Instead, Examiner merely states,

While these "applying a a first force," producing a second force" and how these

forces interact with the finger pad and the bowling ball are not specifically disclosed [in Marinesc], it is noted, that in method claims, the prior art anticipates a claimed invention if the device carries out the method during normal operation.

(See Paper No. [no Paper No., Confirmation Nummer 7581] mailed 6/24/2002, page 3, 11-14), but does not follow that statement with any facts of how the invention described in Claim 14, necessarily flows from the teachings of Marinesc, and in particular, where or how, in Marinesc is disclosed extrinsic evidence of all of the elements recited in Claim 14.

Examiner's reliance on the Doctrine of Inherency rests on his incorrect assumption given in his conclusion that the inherent method of Marinesc is the method recited in Claim 14, and particularly in paragraph d. Examiner's incorrect assumption is in his statement,

... the apparatus of Marinesc and the instant invention are being use (sic) to transmit forces from a bowler's hand to a bowling ball which is old and well known.

First, Examiner's above statement, is incomplete, and ambiguous, and as an incomplete ambiguous statement, is incorrect and misleading.

The ambiguity arises from Examiner's failure to apply that conclusion, above to the elements recited in Claim and Applicants must guess why that statement is relevant to the Claim 14, or what is Examiner's interpretation of the claim that may make that above statement relevant to the grounds of rejection under 102(b). As the Examiner's interpretation of the claims is a core issue, without that interpretation, the relevance of the above statement is missing and Examiner's rejection based on that statement fails the Standard of Substantial Evidence, is frivolous and must be dismissed.

Accordingly, Examiner's statement,

... the apparatus of Marinesc and the instant invention are being use (sic) to transmit forces from a bowler's hand to a bowling ball which is old and well known.

is ambiguous and Examiner has not shown by record facts as required by the Standard of Substantial Evidence, any possible relevance of that statement to the claimed invention.

Second, the method of Marinesc is inoperative in the method of the invention recited in Claim 14, which includes the recitation, from step d,

releasing said finger pad of a bowler, from said finger hole of a bowling ball, to lift said bowling ball.

Applying lift to the ball upon release is old and well known and is taught in Shaffer and by Applicants in the Randall A. Addington's Declaration of record in this application. Shaffer teaches that lift to one skilled in the art of bowling requires first removing the thumb, and then with the thumb removed, using the middle fingers to "rotate the ball upward in an effect called 'lift' , as they leave the ball upon release." Shaffer, col 3, lines 47-55. See Declaration Under 37 CFR 1.132 of Randall A. Addington, Paragraphs 1 to 4, demonstrating he is one skilled in the art and making the same statement about what one skilled in the art would know about "lift" and how a ball is bowled with "lift."

The method of bowling by releasing the ball and applying a force to lift the ball on release, is known and understood on those skilled in the art of bowling, as shown by Shaffer and by the Declaration of Randall A. Addington. As known and understood by those skilled in the art, lift is exclusive of the use the thumb (which is opposite to the disclosed method of Marinese using only the thumb in releasing the ball, but not any other finger, see Marinese, col. 3, lines 40-44. Lift, opposite to the method of Marinese, requires the thumb be first removed and then the ball is released by using the middle two fingers to rotate the underside of the ball upward in an effect called "lift."

The disclosure of Marinese is that the thumb is used exclusively for control, without use of the middle fingers, and Marinese does not teach or disclose lift, as that term is known and understood by those skilled in the art, or how that limited thumb control of Marinese is used or applied to the ball, or any facts related to use of the thumb to lift the ball at release.

Examiner cannot rely on what would be known to one skilled in the art of bowling, in connection with Marinese, because the method of Marinese uses the thumb exclusively (see Marinese, col. 3, lines 40-44), while lift as understood and used by those skilled in the art requires the thumb be removed before any force is applied to lift the ball. There is no teaching or showing in Marinese of lift or how to lift the ball at release, using only the thumb, as taught by Marinese or how to use the thumb "device" of Marinese to release and lift the ball as recited in Claim 14.

How Marinese releases the ball or uses the thumb to control or hook the ball is unknown and it is significant Examiner has provided no information about how Marinese manages to control the ball using only the

thumb. How one would use the method of Marinese to release the ball and apply force to the ball to lift the ball, as recited in Claim 14, is not taught or described anywhere and Examiner has not provided any facts in support of any application of any knowledge of one skilled to Marinese to provide the elements missing from the 102(b) rejection.

Without any disclosure of how to use the thumb device to control the ball, from Marinese, or from the knowledge of one skilled in the art, the thumb device, as disclosed is inoperative for use in the control of the ball and the disclosure of Marinese is limited to the thumb apparatus with no disclosure of any method, inherent or otherwise.

Accordingly, Examiner's statement,

... the apparatus of Marinese and the instant invention are being use (sic) to transmit forces from a bowler's hand to a bowling ball which is old and well known.

is ambiguous and Examiner has not shown by record facts as required by the Standard of Substantial Evidence, any possible relevance of that statement to the claimed invention.

Third, the knowledge of one skilled in the art cannot be applied to, or used with Marinese to cure Marinese's deficiencies as a 102(b) reference. The method of bowling known to those skilled in the art and recited in Claim 14, where lift is applied to the ball at release, requires the thumb first be removed from the ball before lift is applied by the middle two fingers (see Shaffer col. 3, lines 46-56). This method as shown in Shaffer and recited in Claim 14, is the opposite of, and incompatible with, the method used by Marinese where the thumb must be in the ball as it is used to control the ball.

To practice the method of Marinese requires the thumb in the ball. To practice the invention of Claim 14 reciting "lift," requires the thumb be out of the ball. The two methods are exclusive and the teachings of one and the knowledge of one skilled in the art as shown in Shaffer, cannot be used in the operation of Marinese.

The method of Marinese, requiring the thumb exclusively control the ball, cannot be used to practice the method of Claim 14 or achieve the results of the method of Claim 14 (see Randall A. Addington Declaration, Paragraph 5). The recited method of Claim 14, requires lift, as that term is known and understood by those skilled in the art (See Shaffer col. 3, lines 47-57) be applied to the ball on its release (see Claim 14, paragraph d). Marinese is fatally deficient as a 102(b) reference because Marinese does not disclose or teach lift or say anything about lift or how to use the thumb or how the thumb is used to control the ball at its release or the forces and parts

of the thumb involved in the Marinese "thumb control" method, or how to release the ball from the thumb and to lift the ball on its release, as recited in Claim 14, paragraph d, or in any other reference.

Third, Examiner has not shown how one skilled in the art, with or without, the knowledge of one skilled of bowling, as taught in Shaffer and in the Randall A. Addington Declaration, would be able to apply the exclusively thumb control method of Marinese, stated by Examiner in the Final Rejection as,

The apparatus of Marinese transmits the forces applied by the bowler's fingers to the finger pad and then to the bowling ball to control the release and the lift placed on the ball as called for in steps d-f,

(underlining added)

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 9-11), to the method of Claim 14.

Examiner's attempt to use "inherency" to insert into Marinese the facts missing from Marinese and needed to complete Examiner's rejection under 35 USC 102(b), stated by Examiner as,

While these applying a 'first force', 'producing a second force' and how these forces interact with the finger pad and the bowling ball are not specifically disclosed, it is noted that, in method claims the prior art anticipates a claimed invention if the device carries out the method during normal operation.

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 11-14) by relying on the allegation,

... the apparatus of Marinese and the instant invention are being use (sic) to transmit forces fop, a bowler's hand to a bowling ball which is old and well known,

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 18-19)

must fail and be vacated, because the inherent method of Marinese is not disclosed and would not known from the Marinese disclosure by one skilled in the art, for the reasons stated above and is inoperative and cannot be used with the claimed method recited in Claim 14, as demonstrated by Applicants' record facts.

There are no record facts in Marinese which support a rejection under 102(b) explicitly or by the inherent operation of Marinese or by the knowledge of one skilled in the art, because Marinese does not teach lift, with, or without, the thumb or with any other finger, or releasing the ball to lift the ball or how to use the method used by one skilled in the art, as taught by Shaffer and as described in the Randall A. Addington Declaration and as claimed in Claim 14, paragraph d, to lift the ball, which requires the thumb first be removed before the ball is

released and lift is applied to the ball at release, (see Shaff r, col. 3, lines 49-56), when the Marinese disclosure is limited to releasing the ball with the thumb in the bal and without use of any other fingers in used in the control of the ball. As the steps recited in Claim 14, reciting lift, cannot be accomplished with the bowler's thumb in the ball, as taught by Marinese, the inherent operation of Marines is not the same as the method of the recited claimed invention, the inherent operation of Marinese is inoperative with the method of the claimed invention and there can be no anticipation of Claim 14 by Marinese.

Accordingly, the Doctrine of Inherency is not available for use in completing Examiner's rejection under 102(b), and the 102(b) rejection must be vacated.

Fourth, Examiner has not shown, as required by MPEP §2112, by extrinsic evidence the missing descriptive matter is necessarily present in Marinese and that it would be so recognized by persons of ordinary skill in the art, or any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior anticipation, and in particular how Marinese discloses, in its limited disclosure of "thumb control," how,

... in its normal and usual operation, would necessarily perform the method claim. . ."

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 14-16), or how,

The apparatus of Marinese transmits the forces applied by the bowler's fingers to the finger pad and then to the bowling ball to control the release and the lift placed on the ball as called for in steps d-f [of the recited Claim 14 method].

(underlining added)

(See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 9-11).

Fifth, a reading of Appellant's brief, pages 13 to 15, while admitting the method of releasing the ball and upon the release, applying lift to the ball, as disclosed in Shaffer and as described in the record Declaration of Randall A. Addington, is old and well known to those skilled in the art, does not admit Claim 14 is anticipated by this admission or that the inherent method disclosed in Marinese anticipates Claim 14, and Applicants have disputed and contested, in a vigorous adversarial manner, any implication or allegation of Examiner, that while Applicants' inventive method is used in connection with a method of bowling known to those skilled in the art, that the recited invention of Claim 14 is anticipated by that knowledge, or disclosed by Marinese or that methods of Applicants' invention and of Marinese are anything but opposite, incompatible, exclusive and it is impossible to use

one of these methods in the practice of the other (See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 20-23). Accordingly, Claim 14 does not recite any method that may be disclosed in Marinese and Examiner's allegation about what Applicants "admitted" in the Appeal Brief, is unsupported by any record facts and is frivolously made.

2. Claim 15 is not anticipated by Marinese

i. Claim 15, is dependent from claim 14 and recites in part,

said step d . . . includes the step g. of applying a maximum natural force a bowler is capable of producing from said finger pad of a bowler, in a first direction against said first surface of said finger pad shield, through said finger pad shield to said second surface of said finger pad shield, against said interior surface of said finger hole of a bowling ball, and producing said second force in said second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, and wherein said finger pad shield is rigid for distributing said second force in said second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield.

(Underlining added)

Examiner's statement of rejection limited to the "forces" recited in Claim 15 (See Paper No. [no Paper No., Confirmation Number 7581] mailed 6/24/2002), page 3, lines 24-25), has failed to show where Marinese, whether or not explicitly or by inherency, or by skill in the art, discloses each and every recited step of Claim 15, and in particular the underlined elements shown in paragraph 1, above, as required by MPEP §2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e).

Examiner's rejection of Claim 15 has no support by substantial evidence based on record facts and should be vacated.

3. Claim 3 is not anticipated by Marinese.

Claim 3 recites,

The method of claim 14, including the steps of: supporting said finger pad finger pad shield with a

support made of a rigidly deflectable material which holds said finger pad shield in a stable position relative to said support ; and transferring the force of the bowling ball from said finger pad shield to said support to producing a counter force in said support for restoring said support to said stable position.

Examiner has failed to show how Examiner, relying on record facts, as required by the substantial evidence standard and without using his experience or common sense in a way prohibited by the Standard of Substantial Evidence (see III., A., above), has shown in *Marinese* every limitation recited in Claim 3, as required under 102(b) (see MPEP 2131). Examiner's bare statement that Applicants' admitted the limitation of Claim 3 are present in the prior art, referring only to the Appeal Brief, Page 17, middle, without disclosing "what words" used by Applicants establish that alleged admission or how applicants alleged "words" support an admission, fails the Standard of Substantial Evidence and is baseless and frivolous. Applicant has continually disputed the method of *Marinese* is the same or compatible with the method recited in Applicants' claimed invention. Applicants have disputed and contested, in a vigorous adversarial manner, any implication or allegation of Examiner, that while Applicants' inventive method is used in connection with a method of bowling known to those skilled in the art, Applicants admitted the claims are anticipated.

Examiner's rejection of claim 3 should be vacated.

4. Examiner's Rejections of Claims 16, 17, 18, 19, 20, and 21 to 30, have no support by substantial evidence based on record facts and should be vacated.

With regard to Claims 16, 17, 18, and 19, Examiner has not shown by record facts whereior how *Marinese* discloses "[d]istributing the force over the widest area of contact," as recited in Claim 16 or "reducing said pressure substantially within said contact area," as recited in Claim 17, or "distributing said pressure substantially uniformly," as recited in Claim 18, or reducing said pressure substantially within said contact, as recited in Claim 19. Examiner's allegation of Applicants' admissions on pages 19, 20, 21, and 22, of the Appeal Brief, without disclosing "what words" used by Applicants establish that alleged admission or how applicants alleged "words" support and Examiner's rejections of Claim 16 -19, fails the Standard of Substantial Evidence and is baseless and frivolous. Applicant has continually disputed the method of *Marinese* is the same or compatible with the method recited in Applicants' claimed invention.

With regard to Claim 20, Examiner has not shown by record facts where or how *Marinese* discloses "

receiving said second force in said second direction as recited in Claim 16. Examiner's allegation of Applicants' admission on page 19 of the Appeal Brief, without disclosing "what words" used by Applicants establish that alleged admission or how applicants alleged "words" support Examiner's rejection of Claim 16. fails the substantive examination standard and is baseless and frivolous. Applicant has continually disputed the method of Marinese is the same or compatible with the method recited in Applicants' claimed invention. applicant has never admitted Claim

With regard to Claims 21-30, Examiner has not shown by record facts where or how Marinese discloses any recited step in these claims. Examiner's allegation of Applicants' admission on page 19 of the Appeal Brief, without disclosing "what words" used by Applicants establish that alleged admission or how applicants alleged "words" support Examiner's rejection of Claims 21-30, fails the Standard of Substantial Evidence and is baseless and frivolous. Applicant has continually disputed the method of Marinese is the same or compatible with the method recited in Applicants' claimed invention.

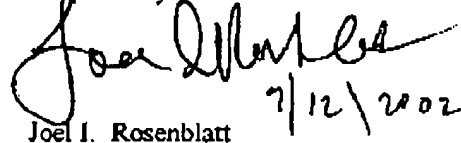
5. Examiner's argument made in the Final Rejection , page 4, lines 9-22, given as therein as,

... one skilled in the art of bowling and viewing Marinese, would have been familiar with the delivery of a bowling ball down the alley and the inherent forces involved,

is stated a conclusion and without any connection to disclosure of Marinese or the claims or what one skilled in the art would have known or how one skilled in the art would have applied that knowledge to Marinese to meet every limitation of each claim and is cumulative to all other arguments made by Examiner on the ground of inherency without adding any new substantive material. Accordingly, this Examiner argument fails the Standard of Substantial Evidence and must be rejected for that reason and for the reasons given above.

Applicant believes all claims in this case and new claim 31, 32, and 33, are in condition for allowance.

Respectfully,



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